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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,114	11/14/2000	Brian Hamiman	3553-4067US1	4946

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EXAMINER	
DIXON, THOMAS A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/716,114	HARNIMAN ET AL.	
	Examiner	Art Unit	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-194* is/are pending in the application.

4a) Of the above claim(s) *15-72,81-132 and 141-194* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14, 73-80, 133-140* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 15-72, 81-132, 141-194 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected groups II-VI, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

2. Applicant argues that the three groups in the restriction requirement is improper, there are, however, 6 groups which comprise 198 claims, and assert no undue burden on the examiner, examiner disagrees, as explained in the restriction requirement. An action on elected group I follows.

Drawings

3. New corrected drawings are required in this application because pages 6-9 are unlabeled and it is unclear what figures they are, from the brief description of drawings, it appears they may be 5A-C and 6A-B. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

4. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that the

"accessing the cobranded website to effectuate said bounce back transaction with at supplier-partner for said second product or service" has already chosen to access, therefore, the step of "choosing not to access said hyperlink" is not an option, because the option has already been chosen.

5. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that the "receiving an acceptance of said conditional purchase offer and a bounceback offer to acquire a second product or service with a hyperlink to a cobranded web site and accessing the cobranded website to effectuate said bounce back transaction with at supplier-partner for said second product or service" has already been informed of the status, therefore, the step of "checking the status of the conditional purchase offer" is not necessary, because the offer's status is accepted.

Claim Rejections - 35 USC § 112 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The termination of the bounceback offer by not choosing to access the hyperlink is not supported.

7. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that the "receiving an acceptance of said conditional purchase offer and a bounceback offer to acquire a second product or service with a hyperlink to a cobranded web site and accessing the cobranded website to effectuate said bounce back transaction with at supplier-partner for said second product or service" has already been informed of the status, therefore, the step of "checking the status of the conditional purchase offer" is not necessary, because the offer's status is accepted.

Claim Rejections - 35 USC § 112 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-15, 73-80, 133-140 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear who/what is transmitting, a conditional purchase offer, and how it is transmitted, further who/what is receiving acceptance and who/what is accepting the offer, then further, who/what is accessing the cobranded website.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 73, 133 are rejected under 35 U.S.C. 102(e) as being anticipated by Travor et al (5,433,347).

As per Claims 1, 73, and 133.
Travor et al ('347) discloses :
transmitting a conditional offer to acquire a first product or service, said conditional purchase offer including a customer-specified price, see column 2, lines 9-33;
receiving an acceptance of said conditional purchase offer and a bounce back offer to acquire a second product or service with a hyperlink to a cobranded web site, see column 2, line 30-61 and column 9, line 46 – column 10, line 32;
accessing said cobranded web site to effectuate said bounceback transaction with a supplier-partner for said second product or service, see column 9, line 46-column 10, line 32.

As per claims 5, 77, 137.
Travor et al ('347) further discloses a jump page, see column 10, lines 30-32.

As per claims 9.
Travor et al ('347) further discloses a making an offer to acquire a second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 10
Travor et al ('347) further discloses receiving an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 11.

Travor et al ('347) further discloses either accepting or rejecting said offer or making a counter offer in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 12

Travor et al ('347) further discloses choosing not to make an offer or accept an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 80, 140.

Travor et al ('347) further discloses receiving, accepting or rejecting an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-3, 74-75, 134-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347).

As per claims 2, 74, 134.

Travor et al ('347) is not limited by type of product or service, but does not specifically disclose the second product or service is an automobile rental, hotel reservation or airline ticket.

Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker et al (5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Travor et al ('347) for the benefit of maximizing sales of products or services.

As per claims 3, 75, 135.

Travor et al ('347) is not limited by type of product or service, but does not specifically disclose the first product or service is a hotel reservation or airline ticket.

Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker et al (5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Travor et al ('347) for the benefit of maximizing sales of products or services.

11. Claims 4, 6-7, 76, 78-79, 136, 138-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347) in view of Microsoft Office 2000 Professional Edition.

As per claims 4, 76, 136.

Travor et al ('347) does not specifically disclose the use of email containing a hyperlink to a cobranded web site.

Official notice is taken that email for communications is old and well known in the art, see assignee's reference Walker et al (5,794,207) column 9, lines 52-59 for the benefit of maximizing communication options.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to communicate with email for the benefit of maximizing communication options.

Microsoft Office 2000 Professional Edition teaches, pages 450-451 embeded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

As per claims 6, 78, 138.

Travor et al ('347) does not specifically disclose a checkbox to defer the offer until a subsequent time.

Microsoft Office 2000 Professional Edition teaches, pages 471 and 480, a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

As per claims 7, 79, 139.

Travor et al ('347) does not specifically disclose an email containing a hyperlink.

Microsoft Office 2000 Professional Edition teaches, pages 450-451 embeded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347) in view of Logan et al (6,199,076).

As per claim 14.

Travor et al ('347) does not disclose inquiring as to said second product or service and receiving through an interactive voice mail feature a referral to said supplier-partner.

Logan et al ('076) teaches the equivalence of voicemail or email files, see column 3, lines 42-56 and column 6-45 for the benefit of convenience to the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email or voicemail as is most convenient to the user.

Prior art made of Record

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al (5,897, 620 and 6,085,169) incorporated by reference teach conditional purchases for airline tickets and email are well known.

Walker et al (5,794,207) figure 5 (515) teaches conditional purchases of airline tickets, hotel rooms, rental cars, insurance, and mortgages are well known; further column 9, lines 52-59 teach use of telephone, facsimile, postal mail or off-line communications tools, but does not disclose voice-mail.

Cameron et al (5,832,459) teaches html pages with link/jump pages are well known.

Nicholson (6,332,128) teaches cross marketing products is well known.

Wayne et al (EP 0 085 546) teaches a vending machine that offers a second item for a reduced price with the purchase of a first item.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Thomas A. Dixon
Examiner
Art Unit 3629

December 30, 2003